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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,895	09/12/2000	Mark Robert Sivik	7885	5900

27752            7590            09/11/2003

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EXAMINER

MRUK, BRIAN P

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 09/11/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/659,895	SIVIK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Brian P Mruk	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 09 June 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-23 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-23 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

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**DETAILED ACTION**

1. This Office action is in response to Applicant's amendment filed June 9, 2003. Applicant has amended claims 1, 6, 8-10, and 16-23. Currently, claims 1-23 remain pending in the application.

The examiner notes that applicant's amendment lists claim 7 as being withdrawn. It appears to the examiner that applicant is attempting to cancel claim 7. Although claim 7 has not been formally canceled, the examiner suggests that applicant should formally cancel claim 7 (i.e. with the term canceled and not withdrawn) in their next response.

2. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office action, Paper No. 7.

3. The objection of claim 23 is withdrawn in view of applicant's amendments and remarks. Specifically, applicant has amended instant claim 23 to change the term "process" to "compound".

4. The rejection of claims 10, 11 and 13 under 35 U.S.C. 112, first paragraph, is withdrawn in view of applicant's amendments and remarks. Specifically, applicant has amended instant claim 10 to remove the non-enabling heterocycle groups.

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5. The rejection of claims 10, 11 and 13 under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicant's amendments and remarks. Specifically, applicant has amended instant claim 10 to remove the indefinite heterocycle groups.
6. The rejection of claims 1-7, 12 and 16-23 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Beyer et al, DE 2,252,186, is withdrawn in view of applicant's amendments and remarks. Specifically, applicant has amended independent claim 1 to require an ether-capped poly(oxyalkylated) alcohol surfactant that contains either a heterocyclic, cyclic, aromatic or polycyclic hydrocarbon radical, which is not taught by Beyer et al, DE 2,252,186.
7. The rejection of claims 1-7, 12 and 16 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wolf et al, WO 95/13260, is withdrawn in view of applicant's amendments. Specifically, applicant has amended independent claim 1 to require an ether-capped poly(oxyalkylated) alcohol surfactant that contains either a heterocyclic, cyclic, aromatic or polycyclic hydrocarbon radical, which is not taught by Wolf et al, WO 95/13260.
8. The rejection of claims 1-23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 09/663,576 is maintained for the reasons of record.

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## **NEW GROUNDS OF REJECTION**

### ***Response to Amendment***

9. The amendment filed June 9, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The newly added groups (ii)-(v) for the variable R<sup>2</sup> in instant claim 1, and the newly added limitations in instant claims 6 and 16 are not supported by the instant specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the examiner notes that the newly added groups (ii)-(v) for the variable R<sup>2</sup> in instant independent claim 1, and the

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newly added limitations in instant claims 6 and 16 are not supported by the instant specification.

### ***Double Patenting***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 09/733,450. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant claims and claims 1-31 of copending Application No. 09/733,450 claim a composition comprising a similar capped poly(oxyalkylated) alcohol compound with similar substituents (see claim 1(a) of copending Application No. 09/733,450), per the requirements of instant claims 1-23.

Therefore, one of ordinary skill in the art would have been motivated to modify claims 1-31 of copending Application No. 09/733,450 to arrive at claims 1-23 of the instant invention, since an artisan of ordinary skill in the art would have had a

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reasonable expectation of success to prepare a similar composition comprising an ether-capped poly(oxyalkylated) alcohol, claimed in the instant invention, with the composition claimed in copending Application No. 09/733,450.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

14. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Mruk whose telephone number is (703) 305-0728. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (Before Final) and (703) 872-9311 (After Final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*BM*  
Brian Mruk  
September 3, 2003

*Brian P. Mruk*  
Brian P. Mruk  
Patent Examiner  
Tech Center 1700